Patent
Attorney's Docket No. 1033539-000021

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	
Ching Man Tsui et al.	Group Art Unit: 2829
Application No.: 10/829,431	Examiner: Vinh P. Nguyen
Filed: April 22, 2004	Confirmation No.: 8776
For: APPARATUS AND METHOD FOR TESTING SEMICONDUCTOR DEVICES	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the rejection of claims 1-4 and 8-12 set forth in the Office Action dated May 7, 2007. This Request is being filed with a Notice of Appeal. No amendments are being filed in response to the Office Action.

The claims are directed to an apparatus for supporting semiconductor devices during testing operations. For a brief description of the claimed subject matter, the Reviewing Panel is referred to the Summary of Claimed Subject Matter appearing in the Appeal Brief filed May 30, 2006.

Claims 1-4 and 8-12 stand rejected under 35 U.S.C. §102, on the basis of the Jeong et al patent (U.S. 5,990,692).[1] In setting forth the rejection, the Office Action states that the claimed recitation of a "groove" is a broad term, and therefore an aperture, such as the Jeong patent's window 22, qualifies as a groove. For the reasons set forth in their previous responses, Applicants' maintain their position that

[1] The Office Action also contains objections to claims 1, 5, 7, 10, 12 and 13. Since those objections are not appealable, they are not addressed herein, and will be attended to upon resolution of the rejection under 35 U.S.C. 102.

such an interpretation is not reasonable, when the plain and ordinary meaning attributed to this term is considered. For the sake of argument in the context of this Request, however, it will be assumed that a window of the type disclosed in the Jeong patent can be considered to constitute a groove.

As set forth in MPEP 2131, to anticipate a claim, the reference must teach every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The rejection fails to meet this requirement, because the Office Action does not establish that the Jeong patent teaches every element of the claim. In fact, the Office Action does not even address the recitations of the claims. Instead, it refers to terminology that appeared in *prior* versions of the claims and that is no longer present in the pending claims.

Claim 1 recites an apparatus for supporting a leadframe during a testing operation. The apparatus comprises a main body and a leadframe support member that is formed with at least one groove. The claim further recites that the groove receives semiconductor devices such that, during the testing operation, leads extending from the devices "rest upon" a surface of the support member.

In rejecting the claims, the Office Action does not even acknowledge this latter feature of the claim, let alone explain how the Jeong patent can be interpreted to disclose such subject matter. If anything, the Jeong patent explicitly teaches away from such a concept. Referring to Figure 4A of that patent, it can be seen that the leads 12 of the semiconductor devices 1 are *suspended* over the window 22. They do not "rest" upon any surface. They are held in their suspended state by adhesive tape 18, as best shown in Figure 2. See column 4, lines 5-8.

As best as can be determined from discussions with the examiner, he is basing his position on the observation that the leads 12 disclosed in the Jeong patent are located on the same plane as the surface of the holding plate 20, which is being interpreted as a support member. This fact is irrelevant, insofar as the *claimed* subject matter is concerned. The claims do not merely recite that a surface of the leads is coextensive with a surface of the support member. They state that the leads "rest upon" the support member. Even given its broadest reasonable interpretation, a person of ordinary skill in the art would not consider this term to encompass a situation such as that illustrated in the Jeong patent, where the leads are suspended over a window. The term connotes physical engagement between the leads and the support member, such that the weight of the leads is opposed by the support member.

The most recent Office Action neither addresses this feature recited in the claims, nor otherwise explains how the reference can be interpreted to disclose it. As such, the Office Action fails to establish the necessary support for a rejection based upon anticipation.

In addition to the foregoing distinction, other differences are recited in the dependent claims. Rather than discuss them herein, the Reviewing Panel is referred to the arguments presented on pages 7-8 of the Amendment filed April 20, 2007.

For at least the foregoing reasons, the rejection of claims 1-4 and 8-12 does not meet the requirements for a rejection under 35 U.S.C. 102, and should be withdrawn.

Respectfully submitted,

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